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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,996	10/11/2006	Peter Frank	47279-5003	6468

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DRINKER BIDDLE & REATH (DC)
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WASHINGTON, DC 20005-1209

EXAMINER

HOWELL, DANIEL W

ART UNIT	PAPER NUMBER
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3726

NOTIFICATION DATE	DELIVERY MODE
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05/13/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DBRIPDocket@dbr.com
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Office Action Summary	Application No. 10/551,996	Applicant(s) FRANK, PETER	
	Examiner Daniel W. Howell	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1-12-07</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the polygonal pin of claim 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have numerous recitations of the phrases “in particular” and “preferably,” such that it is not clear that the associated structure is present or not. See claim 1, lines 1-2, claim 7, line 3, claim 9, line 2, claim 11, line 4, claim 15, line 4, claim 19, line 2, and claim 23, line 4, though the claims should be checked to see if any more exist. The claims

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should be appropriately amended such that it is clear if these items are present or not. Claim 1 begins, “Base body for drilling....,” and claim 15 begins, “Cutting insert holder for use with a base body according to claim 1.” Such language makes it ambiguous on if Applicant intended for this to be an independent or dependent claim. Since claim 15 and the subsequent dependent claims reference structure of the base body, claim 15 should be placed in conventional dependent claim format. Claim 21 has been improperly amended such that it doesn’t depend from any claim. [It will be treated as if it depends from claim 1 in the rejection below.]

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 7, 8, 10, 14-17, 21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 344616. Body 2 has threaded holes 25 for reception of screws/cylindrical pins 7. Two cutting insert holders 5 have elongated holes 17 through which the screws 7 extend in order to secure the holders to the body. Each holder 5 has a screw 10 that pushes against screw/pin 7 as it is rotated, in order to adjust the holder radially. The measurement set forth in claim 1 may be made. As seen from figure 10, the body has a U-shaped groove 37 for reception of projections 38 of the insert holders 5a. Regarding claim 10, the screw 7 has a variable retaining force, as it may be tightened between tightly or loosely.

5. Claims 1-4, 7-8, 10, 14, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by German 2746232. Body 1 has four radial mostly U-shaped slots for reception of four insert holders 6, 7. A pin 4 is located on the tool axis, and each holder 6, 7, has a screw 15 that pushes

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against this pin to adjust the cutter holders radially. As seen from figure 2, the holders have projections that slide in the radial slots 3. The measurement set forth in claim 1 may be made. Regarding claim 10, the retaining screws 16, 17 have a variable retaining force, as it may be tightened between tightly or loosely.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over German '232 in view of Healy (2204855). Depending on the workpiece requirements, it is conventional to provide an appropriate number of cutting inserts. Healy shows a boring head having three cutting holders/inserts 20, 21. In view of this teaching of Healy, it is considered to have been obvious to have provided German '232 with three cutting inserts and holders depending on what it needed for the particular workpiece.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP '616 in view of Healy (2204855). Depending on the workpiece requirements, it is conventional to provide an appropriate number of cutting inserts. Healy shows a boring head having three cutting holders/inserts 20, 21. In view of this teaching of Healy, it is considered to have been obvious to have provided EP '616 with three cutting inserts and holders depending on what it needed for the particular workpiece.

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9. Claims 5, 9, 11-13, 18-20, and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, David Bryant, may be reached at 571-272-4526.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3726 at the top of your cover sheet.

/Daniel W. Howell/

Primary Examiner, Art Unit 3726